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R HOHBACH TEST

NO. 5571 P. 2

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

GREGORY E. ROSS

Serial No.: (not assigned)

Filing Date: 29 October 1999

For: PERIMETER COATING
ALIGNMENT

Reissue Application for:

U.S. Patent No. 5,830,529

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BOX RE-ISSUE

Assistant Commissioner for Patents
Washington, D.C. 20231**RE-ISSUE DECLARATION OF GREGORY E. ROSS**

I, Gregory E. Ross, applicant herein and sole inventor of U.S. patent no. 5,830,529
declare as follows:

1. I am a citizen of Australia, and my residence and my post office address is
2007 Long Leaf Court, Santa Rosa, California 95403.

2. I believe myself to be the original, first, and only inventor of the invention
described and claimed in U.S. Letters Patent 5,830,529, and in the Specification filed
herewith, for which invention a re-issue patent is sought.

NOV. 3. 2000 4:07PM

R HOHBACH TEST

NO. 5571 P. 3

3. I have reviewed and understand the content of the Specification filed herewith, and I have reviewed and understand each new claim presented in this re-issue application.

4. I believe U.S. Letters Patent 5,830,529 to be partly defective or inoperative by reason of the patent claiming claimed less than I, as inventor, had a right to claim, which error and omission in the scope of the claims arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention.

5. One insufficiency in the claims concerns Claim 1, which states:

1. A method of forming a pattern of color coatings onto a light permeable panel with exact registration between successive color coatings along defined edges of the pattern, and wherein the panel with the pattern of color coatings formed thereon for use as a one-way vision panel, the method comprising the steps of:

- a) providing a base material having an ink printable release coating on one side thereof;
- b) applying a first color coating to the printable release coating side or said base material;
- c) applying at least one additional color coating over at least a portion of said first color coating;
- d) perforating said base material with said color coatings to provide a pattern of perforate and non-perforate portions to achieve exact registration of said at least one additional color coating with said first color coating for achieving one-way vision effects;
- e) transferring said pattern of color coatings from said non-perforate portions of said base material onto a surface of a light permeable panel maintaining the exact registration; and
- f) heating said light permeable panel to fuse said pattern of color coatings onto said surface of said light permeable panel.

6. Another insufficiency in the claims concerns Claim 12, which states:

12. A method of forming a laminate pattern of color coatings onto a light permeable panel with exact registration between successive color coatings along defined edges of the pattern, and wherein the panel with the laminate pattern of color coatings formed thereon for use as a one-way vision panel, the method comprising the steps of:

- a) providing a base material having an ink printable release coating on one side thereof;
- b) cutting the base material to provide a desired pattern of perforate and

NOV. 3. 2000 4:08PM

R HOHBACH TEST

NO. 5571 P. 4

non perforate portions for attaining exact registration of successively applied layers of color coatings suitable for one-way vision effects;

c) applying a first color coating to the non-perforate portions of the printable release coating side of the base material;

d) applying at least one additional color coating over at least a portion of the first color coating, the application of the additional color coating to the first color coating defining a laminate pattern of color coatings with exact registration along defined edges of the remaining non-perforate portions of the cut base material;

e) transferring the laminate pattern of color coatings onto a surface of a light permeable panel maintaining the exact registration; and

f) heating the light permeable panel to fuse the laminate pattern of color coatings onto the surface of the light permeable panel.

8. When Claim 1 and Claim 12 were drafted, I believed that I was entitled only to patent protection for methods that included every single step recited in these two claims. However as the two-year anniversary following issuance of USP 5,830,529 on 3 November 1998 approached, I reviewed this patent with respect to adequacy of the existing claims. In the course of that review, I concluded that the claims in USP 5,830,529 inadvertently claimed less than I as inventor was entitled to claim.

As such, I now realize it was not necessary to claim, as I did in original Claim 1, that the base must be part of a light permeable panel (claim 1, preamble), or that the coatings must be used in a one-way vision panel (claim 1, preamble), or that the base material must have an ink printable release coating on one side (claim 1(a)), or that different colors be associated with different coating layers (claim 1(b) and 1(c)), or that the base material must be perforated with the color coatings (claim 1(d)). Further, I now realize it was not necessary to claim, as I did in original Claim 1, that there be a transfer of the pattern of color coatings from non-perforate portions of the base material onto as surface of a light permeable panel maintaining the exact registration (claim 1(e)). Finally, I now realize it was not necessary to claim, as I did in original Claim 1, that it is necessary to heat the light permeable panel to fuse the pattern of color coatings onto the surface of the light permeable panel (claim 1(f)).

As such, I further now realize that it was not necessary to claim, as I did in

NOV. 3. 2000 4:09PM

R HOHBACH TEST

NO. 5571 P. 5

original Claim 12, that the base material must have an ink printable release coating

9. Thus, I have now caused to be filed herewith a reissue application with new claims 23-55 that augment and are broader in scope than claims 1-22 issued in USP 5,830,529. As sole inventor, I believe I am entitled to a re-issued patent that includes the new, broader, claims presented herewith, and that no prior art reference known to me discloses or suggests the invention defined by new claims 23-55.

Support for my new claims is found as follows, with reference to my original U.S. patent no. 5,830,529:

Claim 23 support appears in Fig. 4C, and col. 9, line 66 (the base), col. 5, line 41 (the coat or coating), col. 5, lines 24-41 (the edge), and col. 5, lines 5-16 (the perimeter).

Claim 24 is supported by Figs. 38A, and 39A-39C, and col. 1, line 42 bridging col. 2, line 25.

Claim 25 support is as follows: support for the preamble is found in Figs. 38A and 39A-39C, and col. 1 line 42 bridging col. 2, line 25 (transfer), support for (i) is found at col. 14, line 40 (heat), support for (ii) is found at col. 1 line 42 bridging col. 2, line 25, and col. 19, line 40 (pressure), and support for (iii) is further found in Fig. 46C.

Claim 26 support is found as follows: (i) is supported by Fig. 42 and col. 2, line 62 (opaque), (ii) is supported col. 5, lines 41-63 (ink), (iii) is supported by col. 1 line 42 bridging col. 2, line 25 (ink by printing), (iv) is supported by col. 25, line 29 (ceramic ink), (v) is supported by col. 21, lines 64-66 (inked indicia), and (vi) is supported by col. 5, line 45 (metal).

Claim 27 support is found in Fig. 37F.

Claim 28 is supported by Figs. 21B, 33, and 37B.

NOV. 3. 2000 4:09PM

R HOHBACH TEST

NO. 5571 P. 6

Claim 29 support is found at col. 10, line 3.

Claim 30 support is as follows: (i) is supported by col. 2, line 62, (ii) is supported by col. 5, lines 41-63, and (iii) is supported by col. 21, lines 64.

Claim 31 support is found at col. 2, line 15.

Claim 32 step (a) is supported by Figs. 1A and 1B, and col. 19, lines 1-10, step (b) is supported by Figs. 2A -2Q and by col. 20, line 1 bridging col. 21, line 27, and step (c) and step (d) are supported) by Fig. 1B and col. 19, lines 7-10.

Claim 33 support is as follows: (i) is supported by col. 2, line 62, (ii) is supported is supported by col. 5, line 60 and col. 94, line 17, (Ili) is supported by col. 1, line 49 bridging col. 2 line 27, (iv) is supported by col. 1, lines 48-55, (v) is supported by Fig. 49C and col. 1, line 41, (vi) is supported by col. 5, line 61, and col. 26, line 29, and (vii) is supported by col. 2, line 15 and col. 2, line 56.

Claim 34 is supported by Figs. 1A-1E, Figs. 37A-37, Figs. 38A-38B, and Figs. 39A-39C.

Claim 35 is supported by (i) col. 9, line 25, and (ii) col. 9, line 24.

Claim 36 is supported by Figs. 1A and 1B.

Claim 37 is supported by Figs. 35A and 35B; more particularly (vi) is supported by Fig. 22B. (vii) is supported by Fig. 16, (viii) is supported by Figs. 21B and 22B, and by col. 7, line 13. (ix) is supported by col. 34, line 14, (x) is supported by Fig. 4D, Figs. 12A-12D, and Fig. 21A.

Claim 38 is supported by col. 6, line 30; (v) is further supported by Figs. 40B-40E, Figs. 41A-41D, (vi) and (vii) are supported by Figs. 24A-24H..

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NO. 5571 P. 7

Claim 39 is supported by Figs. 5A and 5B, and Fig. 10A.

Claim 40 is supported as follows: (i) is supported by Figs. 5A-5B, (ii) is supported by col. 23, line 44, (iii) is supported by col. 23, line 43, (iv) is supported by col. 26, line 60, and 40(v) is supported by col. 23, line 41.

Claim 41 is supported by col. 77, line 2.

Claim 42 is supported as follows: (i) is supported by Figs. 24F, 25B, 42A, and col. 21 lines 64-66, (ii) is supported by col. 67, line 36, (iii) and (iv) are supported by col. 35, line 4, (v) is supported by Fig. 49A and col. 18, line 6, (vi) is supported by Figs. 5A-5B, (vii) is supported by Fig. 43E, (viii) is supported by col. 1, lines 42-43, and col. 18, line 11, (ix) is supported by col. 1, line 24, and (x) is supported by col. 24, line 64.

Claim 43 is supported as follows: (i) is supported by Figs. 1, 24F, 16, 31B, 34, 35A, and Figs. 37A-37G, (ii) is supported by col. 30, line 11, (iii) - (vii) is supported by Fig. 4C, and col. 30, line 9, (viii) is supported by col. 37, lines 26-51, and (ix) is supported by Fig. 38B and by Figs. 50M and 50N.

Claim 44 (i) is supported by Figs. 3A, 4B-4C, and Fig. 40A, (ii) is supported by Figs. 3A-3C, and (iii) is supported by Figs. 50G, 50H, 50O and 50P.

Claim 45 is supported by Fig. 4B combined with Fig. 4C.

Claim 46 is supported by Figs. 43A-43E.

Claim 47 is supported as follows: (i) is supported by Figs. 38A-38, Figs. 47A-47D, and Figs. 48A-48D, and (ii) is supported by Figs. 37A and 37B, and by Fig. 41C.

Claim 48 is supported by Fig. 41C.

NOV. 3. 2000 4:10PM

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NO. 5571 P. 8

Claim 49 is supported as follows: (i) is supported by Fig. 40B, and (ii) is supported by col. 30, line 46.

Claim 50 is supported by Fig. 21B.

Claim 51 is supported by col. 9, line 66, col. 5, lines 25-41.

Claim 52 is supported by Fig. 1B.

Claim 53 is supported as follows: (i) is supported by col. 21, lines 64-66, (ii) is supported by Fig. 21B, (iii) is supported by col. 8, lines 24-31, (iv) is supported by col. 1, line 55, and col. 2, line 4.

Claim 54 is supported as follows: is supported by col. 1, line 42 bridging col. 2, line 4.

Claim 55 is supported by col. 5, lines 41-64.

10. I acknowledge a duty to disclose information material to examination of this application.

11. I declare that all statements made herein are of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that these statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the U.S.C., and that such willful false statement may jeopardize the validity of the application and any patent issued thereon.

Dated: November 3, 2000

Signed: 

Gregory E. Ross
Applicant

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NO. 5523 P. 4/5

POWER OF ATTORNEY FOR PATENT APPLICATION

I, Gregory E. Ross, am the sole inventor, patentee and owner of U.S. Patent No. 5,830,529 issued 3 November 1998 and entitled *PERIMETER COATING ALIGNMENT*.

I hereby appoint the following attorneys to file and prosecute a broadened reissue application of said U.S. Patent No. 5,830,529 and to transact all business in the Patent and Trademark Office in connection therewith: Harold C. Hohbach, Reg. No. 17,757; Aldo J. Test, Reg. No. 18,048; Donald N. MacIntosh, Reg. No. 20,316; Edward S. Wright, Reg. No. 24,903; David J. Brezner, Reg. No. 24,774; Richard E. Backus, Reg. No. 22,701; James A. Sheridan, Reg. No. 25,435; Robert B. Chickering, Reg. No. 24,286; Richard F. Trecartin, Reg. No. 31,801; Steven F. Caserza, Reg. No. 29,780; Michael A. Kaufman, Reg. No. 32,998; Edward N. Bachand, Reg. No. 37,085; R. Michael Ananian, Reg. No. 35,050; Robin M. Silva, Reg. No. 38,304; David C. Ashby, Reg. No. 36,432; and Maria S. Swiatek, Reg. No. 37,244; provided that if any one of said attorneys ceases being affiliated with the law firm of FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP as partner, employee or of counsel, such attorney's appointment as attorney and all powers derived therefrom shall terminate on the date such attorney ceases being so affiliated.

Direct all telephone calls to Michael A. Kaufman at (415) 781-1989.

Address all correspondence to:

Michael A. Kaufman
Flehr Hohbach Test Albritton & Herbert LLP
Four Embarcadero Center - Suite 3400
San Francisco, California 94111-4187
Attorney Docket No. RI-69912/MAK

IN WITNESS WHEREOF, I have executed this instrument as of the date first below written.

Signature: Name Gregory E. RossDate: 3 November 2000

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NO. 5523 P. 5/5

Applicant or Patentee: Gregory E. ROSSSerial or Patent No.: Not Yet KnownFiled or Issued: Herewith

Attorney Docket No.:

RI-69912/MAKFor: PERIMETER COATING ALIGNMENT**VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY
STATUS (37 CFR 1.9(c) and (f) and 1.27(b)) - INDEPENDENT INVENTOR**

As a below named inventor, I hereby declare that I qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying reduced fees under Section 41(a) and (b) of Title 35, United States Code, to the Patent and Trademark Office with regard to the invention entitled PERIMETER COATING ALIGNMENT

described in

☒ the specification filed herewith☐ application serial no. _____, filed _____☐ patent no. _____, issued _____

I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who could not be classified as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:

☒ no such person, concern, or organization☐ person, concerns or organizations listed below*

* NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)

FULL NAME _____

ADDRESS _____

☐ Individual☐ Small Business Concern☐ Nonprofit Organization

FULL NAME _____

ADDRESS _____

☐ Individual☐ Small Business Concern☐ Nonprofit Organization

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Signature of Inventor

Gregory E. ROSS

Name of Inventor

3 November 2000

Date

Signature of Inventor

Name of Inventor

Date

Signature of Inventor

Name of Inventor

Date

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NO. 5523 P. 2/5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**PATENT**

In re application of:

GREGORY E. ROSS

Serial No.: (not assigned)

Filing Date: 29 October 1999

For: **PERIMETER COATING
ALIGNMENT**

Reissue Application for:

U.S. Patent No. 5,830,529Jc926 U.S. PTO
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WASHINGTON, D.C. 20231.TYPED NAME **Todd V. LEONE**SIGNED **BOX RE-ISSUE**Assistant Commissioner for Patents
Washington, D.C. 20231**OFFER TO SURRENDER PATENT BY REISSUE APPLICANT AND INVENTOR**I, Gregory E. Ross, am applicant herein and am the sole inventor of U.S. patent
no. 5,830,529.I have never assigned my U.S. patent no. 5,830,529 and ownership of this patent
remains with me.

I hereby offer to surrender my U.S. patent no. 5,830,529.

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NO. 5523 P. 3/5

I declare that all statements made herein are of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that these statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the U.S.C., and that such willful false statement may jeopardize the validity of the application and any patent issued thereon.

Dated: November 3, 2000

Signed: 

Gregory E. Ross
Applicant